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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
VU, THONG H	

ART UNIT	PAPER NUMBER
2142	

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/727,334	GOODWIN ET AL.	
	Examiner	Art Unit	
	Thong H Vu	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 June 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Claims 1-6 are pending.

Claims 1-6 are amended. Thus, the Final Rejection is appropriate.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 are rejected under the judicially created doctrine of double patenting over claims 1-8 of U. S. Patent No. 6,757,683 B2 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Patent '683: (Claim 4). A web content downloading method for a network kiosk comprising the steps of:

(a) storing a list of web content addresses in a storage medium by the kiosk;

(b) displaying a web page by the kiosk;

(c) increasing speed of displaying subsequent web pages by (c-1) determining links to web content at subsequent depths in the web page by the kiosk; (c-2) determining whether the links to the web content are in the list of web content addresses by the kiosk; (c-3) if the links to the web content are in the list of web content addresses, contacting a number of servers in a global network where the web content at the subsequent depths is stored, downloading the web content from the global network, and storing the web content in the storage medium before displaying another web page by the kiosk; and (c-4) repeating steps (c-1) through (c-3) by the kiosk until a download limit in the list is exceeded;

(d) recording selection of the other web page by the kiosk;

(e) determining whether the web content associated with the other web page was stored in the storage medium by the kiosk;

(f) if the web content associated with the other web page was stored in the storage medium by the kiosk, obtaining the web content associated with the other web page from the storage medium, and displaying the web content displaying the web content associated with the other web page by the kiosk; and

(g) if the web content associated with the other web page was not stored in the storage medium by the kiosk, contacting the servers of the global network, downloading the web content associated with the other web page, and displaying the web content associated with the other web page while remaining connected to the global network by the kiosk.

Application (Claim 4) a method of displaying a web page comprising the steps of

(a) storing a list of web content addresses and corresponding download time criteria;

(b) comparing a current time with the download times;

(c) determining first download times which are after the current time;

(d) downloading and storing web content at first web content addresses corresponding to the first download times in the list in a storage medium by the kiosk, before user selection of the web content addresses;

(e) recording an address of the web page by the kiosk;

(f) reading first web content identified in the web page which is located in the storage medium by the kiosk; and

(g) displaying the web page with the first web content.

It was obvious "the download limit in the list" means the download times which will be used to compare to the current time [see Patent '683 specification, col 3 lines 44-54].

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6 are rejected under 35 U.S.C. § 102(e) as being anticipated by Ferguson [6,769,019 B2].

3. As per claim 1, Ferguson discloses a web content downloading method for a network kiosk [Ferguson, the client computer, col 4 lines 1-13] comprising the steps of:

(a) determining a number of web content addresses and corresponding download times [Ferguson, a list of Q-link and Q-touch content to be downloaded, col 6 lines 29-32; a downloaded procedure with a predetermined period of time, col 12 lines 38-50; the content is downloaded before issuing a second request (or user selects), col 10 lines 7-18]; and

(b) downloading and storing web content at the web content addresses at the download times by the kiosk [Ferguson, the download agent automatically activated only after a pre-determined period of time, col 12 lines 37-50; last download, a suitable time slot is acquired the list of resources need to be downloaded, col 13 lines 17- col 14 lines 42], before user selection of the web content addresses [Ferguson, display the list to the user for selection, col 10 lines 1-3]. Thus, it was clearly that Ferguson taught the client software downloads the list for Web link selections including the content with a predetermined period of time wherein the download information (or time) is displayed.

4. Claims 2,3 and 5 contain the similar limitations set forth of method claim 1. Therefore, claims 2,3,5 are rejected for the similar rationale set forth in claim 1.

5. As per claim 4, Ferguson discloses a method of displaying a web page comprising the steps of

(a) storing a list of web content addresses and corresponding download time criteria [Ferguson, a list of Q-link and Q-touch content to be downloaded, col 6 lines 29-32];

(b) comparing a current time with the download times [Ferguson, comparing the list update with the last download stamp, col 13 lines 17-col 14 lines 42];

(c) determining first download times which are after the current time;

(d) downloading and storing web content at first web content addresses [Ferguson, the application detects the necessity to update the content from the Web

server, col 13 lines 55-65] corresponding to the first download times in the list in a storage medium by the kiosk, before user selection of the web content addresses [Ferguson, display the list to the user for selection, col 10 lines 1-3];

(e) recording an address of the web page by the kiosk [Ferguson, URL, col 7 line 65-col 8 line 11];

(f) reading first web content identified in the web page which is located in the storage medium by the kiosk [Ferguson, download information is displayed on the client monitor, col 8 lines 12-34]; and

(g) displaying the web page with the first web content [Ferguson, Web page, col 7 lines 8-25].

6. Claim 6 contains the similar limitations set forth of method claim 4. Therefore, claim 6 is rejected for the similar rationale set forth in claim 4.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-6 are rejected under 35 U.S.C. § 103 as being unpatentable over Himmel [6,041,360] in view of Ito [6,302,795 B1].

8. As per claim 1, Himmel discloses a web content downloading method for a network kiosk comprising the steps of:

(a) determining a number of web content addresses (and corresponding download times) [Himmel, a server with a dynamic updated bookmark, abstract]; and

(b) downloading and storing web content at the web content addresses (at the download times) by the kiosk [Himmel, the bookmark is selectable by user, abstract].

However Himmel does not explicitly detail the download information included the time.

A skilled artisan would have motivation to implement the download process and found Ito teaching. Ito discloses a data processing system includes a portable device downloads a program/file/list of addresses on a time limit and compares this time limit against the current time [Ito, abstract]. An Official Notice is taken that the technique of comparing the downloaded time of a document over network with the current time is well-known in the art [see Ballard, Judson, Dujari, Killian references]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate technique of comparing the download time with the current time as taught by Ito into the Himmel's apparatus in order to utilize the download information. Doing so would provide a dynamic and efficiency information to help client makes decision to select and download document via Internet.

Thus, the prior art clearly taught the list of web content were downloaded to the client node before the user makes a selection based on the download times.

9. Claims 2,3 and 5 contain the similar limitations set forth of method claim 1. Therefore, claims 2,3,5 are rejected for the similar rationale set forth in claim 1.

10. As per claim 4, Himmel discloses a method of displaying a web page comprising the steps of

(a) storing a list of web content addresses and corresponding download time criteria [Himmel, the browser can only access the URLs addresses, col 9l ines 60-67];

(b) comparing a current time with the download times [Ito, compares time limit against the current time, col 5 line 60-6 line 14,50-63];

(c) determining first download times which are after the current time [Ito, time stamp when the program is downloaded, col 8 lines 5-12];

(d) downloading and storing web content at first web content addresses corresponding to the first download times in the list in a storage medium by the kiosk, before the kiosk displays any of the web content [Himmel, downloading the bookmark from a Web servers, col 13 lines 27-41];

(e) recording an address of the web page by the kiosk [Himmel, a downloaded bookmark, abstract];

(f) reading first web content identified in the web page which is located in the storage medium by the kiosk [Himmel, the user selects a URL, col 5 lines 27-40]; and

(g) displaying the web page with the first web content [Himmel, retrieval of a specific web page, col 5 lines 40-56].

11. Claim 6 contains the similar limitations set forth of method claim 4. Therefore, claim 6 is rejected for the similar rationale set forth in claim 4.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (703)-305-4643.

The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Jack Harvey*, can be reached at (703) 305-9705.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9700.

Any response to this action should be mailed to: Commissioner of Patent and Trademarks, Washington, D.C. 20231 or faxed to :

After Final (703) 746-7238
Official: (703) 746-7239
Non-Official (703) 746-7240

Hand-delivered responses should be brought to Crystal Park 11,2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Thong Vu
Patent Examiner
Art Unit 2142